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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,296	09/25/2006	Takayoshi Moriyama	094500205427-US0	6616
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EXAMINER WILLIAMS, AARON				
ART UNIT 2889		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,296

Applicant(s)

MORIYAMA ET AL.

Examiner

Aaron Williams

Art Unit

2889

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 7, 9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 7, 9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Receipt is acknowledged of applicant's amendment filed 1/28/2009. Claims 1-3, 5-6, 8 and 10 have been canceled. Claims 4, 7, 9, 11 are pending and an action on the merits is as follows.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

The objection to the drawings in the office action of October 28, 2008 for the informality of failing label or describe the vertical axis in the graph of Figure 6 is rendered moot since a replacement sheet has accompanied the present amendment.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 4, 7, 9, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Grant Publication 2003/0080341 to Sakano et al., herein refer to as Sakano.

Regarding claim 4 Sakano discloses a light emitting device comprising: a light emitting element (Figure 8, LED chip (5), paragraph [0091]), disposed on a base member (Figure 10A, mount lead (42a), paragraph [0270]); and a phosphor layer

(Figure 8, the phosphor particles (81) form a layer over the LED chip (5) paragraph [0082]), the phosphor layer having a phosphor that emits visible light upon being excited by light emitted from the light emitting element and includes phosphor particles (Further refer to paragraphs [0095], [0128]), which are secondary particles having a particle diameter in a range of 5 to 10 μ m (refer to paragraph [0256]) that are formed by the binding of small particles of the phosphor (refer to [0122]).

The statements are "formed by filling and solidifying a resin with a viscosity in the range of 0.1 to 10 Pa*s" and "in a crystal growth process" are product by process limitation. Initially, with respect to claims a **"product by process"** claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15. See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554, does not deal with this issue); In re Fitzgerald 205 USPQ 594, 596 (CCPA); In re Marosi et al , 218 USPQ 289 (CAFC); and In re Thorpe et al, 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the patentability of the final product per se which must be determined in a **"product by process"** claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear.

Regarding claim 7 Sakano discloses wherein the light emitting element includes a light emitting diode element that emits a blue light (Figure 8, LED chip (5) can emit

light from 365-700 nm, refer to paragraph [0091]), and the phosphor includes a yellow to orange light emitting phosphor that emits yellow light or orange light upon being excited by the blue light emitted from the light emitting diode element (Figure 8, fluorescent material with peak emission at around 580-700 nm, refer to paragraph [0128]).

Regarding claim 9 Sakano discloses an illuminating device, comprising: a light emitting element (Figure 8, LED chip (5), paragraph [0091]), disposed on a base member (Figure 11, mount lead (42a), paragraph [0270]); and a phosphor layer (Figure 8, the phosphor particles (81) form a layer over the LED chip (5) paragraph [0082]), the phosphor layer having a phosphor that emits visible light upon being excited by light emitted from the light emitting element and includes including phosphor particles (Further refer to paragraphs [0095], [0128]), which are secondary particles having a particle diameter in a range of 5 to 10 μ m (refer to paragraph [0256]) that are formed by the binding of small particles of the phosphor (refer to [0122]) and a lens disposed on the base member (Figure 11, Lens (49), refer to paragraph [0127]).

The statements are "formed by filling and solidifying a resin with a viscosity in the range of 0.1 to 10 Pa*s" and "in a crystal growth process" are product by process limitation. Initially, with respect to claims a **"product by process"** claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15. See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554, does not deal with this issue); In re Fitzgerald 205 USPQ 594, 596 (CCPA); In re Marosi et al, 218 USPQ 289 (CAFC); and In re Thorpe et al, 227 USPQ 964 (CAFC, 1985) all of

which make it clear that it is the patentability of the final product per se which must be determined in a "**product by process**" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear.

Regarding claim 11 Sakano discloses a light emitting device according to claim 4, wherein the phosphor layer includes phosphor particles with a particle size distribution in which two or more peaks are present (Figure 2B, shows to two peak particle size distributions paragraph [0101]).

Response to Arguments

4. Applicant's arguments with respect to claims 4, 7, 9, 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Williams whose telephone number is (571) 270-5279. The examiner can normally be reached on Monday thru Friday 7:00 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Toan Ton can be reached on (571)272-2303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Aaron Williams/
Examiner, Art Unit 2889

/Karabi Guharay/
Primary Examiner, Art Unit 2889